Application Serial No. 10/032,032
Amendment dated September 27, 2005
Reply to Office Action dated August 30, 2005
REMARKS:

Status Of Claims

Claims 1-23 and 25-38 were previously pending. Claims 1, 7, and 23 have been amended. Claim 26 has been canceled without prejudice or disclaimer. Thus, claims 1-23, 25, and 27-38 are currently pending in the application with claims 1, 7, 14, 23, and 28 being independent.

Office Action

In the Office Action, the Examiner rejected claims 1-23 and 25-38 under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, U.S. Patent No. 5,654,908. The Examiner also rejected claims 1-23 and 25-38 under 35 U.S.C. 102(e) as being anticipated by Obradovich et al., U.S. Patent No. 5,529,824.

The August 30, 2005 Office Action was improperly made final. The May 5, 2005 Office Action contained only one ground of rejected. Specifically, in the May 5, 2005 Office Action, the Examiner rejected claims 1-23 and 25-38 under 35 U.S.C. 102(b) as being anticipated by Yokoyama. The Examiner has withdrawn that ground of rejection and replaced it with the two grounds discussed above. Furthermore, on page 3 of the August 30, 2005 Office Action, the Examiner states "Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action". Thus, the Examiner acknowledges that new grounds of rejection have been applied against all of the claims.

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However, all of the claims have not been amended. For example, claims 14 and 28, were not amended in any way. Furthermore, claim 23 was amended only to correct a purely typographical error. Specifically, the word "and" was relocated from line 4 to line 5. Surely, the Examiner does not contend that such an amendment imparted patentability over the previous ground of rejection. Therefore, Applicant's arguments were held persuasive, at least with respect to claims 14, 23, and 28. Thus, by withdrawing the previous ground of rejection and applying new grounds of rejection, the August 30, 2005 Office Action was improperly made final, at least with respect to claims 14, 23, and 28. As a result, Applicant respectfully requests that the finality of the August 30, 2005 Office Action be withdrawn and this amendment entered.

In any case, Applicant respectfully asserts that the currently pending claims distinguish the present invention over Yokoyama, Obradovich, and the other prior art references made of record, either alone or in combination.

Specifically, claims 1 and 7 each recite "Integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device".

In contrast, as previously argued, Yokoyama simply does not teach these limitations. Rather, Yokoyama teaches an electronic diary 10, having some PDA functionality and a completely separate navigation apparatus 50 which provides GPS capabilities. Specifically, as disclosed in column 3, lines 42-49:

> The electronic diary 10 transmits the data which specifies a selected destination, for example an address or a telephone number (hereinafter referred as destination data) to navigation apparatus 50 via radio waves or the like, when a user M selects the desired destination. Having received the

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destination data, navigation apparatus 50 establishes the intended route to the destination, ready for guiding the user M along the route when user M gets into the motor vehicle.

As disclosed in column 6, lines 16-21:

> The navigation apparatus obtains corresponding coordinates (latitude and longitude) based on the destination data consisting of the address data.... The navigation apparatus 50 then sets up the co-ordinates as the destination and establishes the intended route to the destination.

As disclosed in column 5, lines 4-8 and lines 36-38:

> The memory unit 57 [of the navigation apparatus 50] stores various destination set-up data consisting of coordinates of the destinations and intersections near the destinations, and road information such as map data and road data for searching the routes... image display unit 56 [of the navigation apparatus 50] displays an edited map based on the map data sent from memory unit 57...

Therefore, Yokoyama requires two devices, one to provide some PDA functionality and another to provide some GPS capabilities. Thus, Yokoyama actually teaches away from combining both PDA functionality and GPS capabilities in one device, as presently claimed. As a result, Yokoyama simply does not disclose, suggest, or make obvious "integrating PDA address book functions with Global Positioning System (GPS) capabilities in a single device", as claimed in claims 1 and 7.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in

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the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In meeting this initial burden, as stated in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art

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suggested the desirability of the modification." *In re Fritch,* 23 USPQ2d 1780, 1783-84

(Fed. Cir. 1992); *see also In re Gordon,* 221 USPQ2d 1125, 1127 (Fed. Cir. 1984).

Additionally, "if the proposed modification would render the prior art invention being

modified unsatisfactory for its intended purpose, then there is no suggestion or motivation

to make the proposed modification." MPEP §2143.01.

In the present case, the Examiner acknowledges that "Yokoyama lacks that the

GPS capabilities are within the PDA device". However, the Examiner failed to combine

Yokoyama with a reference that teaches this limitation, as required of a *prima facie* case

of obviousness. Furthermore, the Examiner failed to provide the requisite motivation or

suggestion for that combination. In fact, as discussed above, Yokoyama explicitly teaches

separation of such functionality, thereby explicitly teaching away from the claimed

invention. Therefore, Yokoyama simply cannot provide the requisite motivation. As a

result, the Examiner has failed to properly establish a *prima facie* case of obviousness, and

the present obviousness rejections cannot be sustained.

Claim 1 further now recites "identifying a location", "associating a Personal Digital

Assistant (PDA) address book entry with the location to form a waypoint", and "wherein the

location is identified and the PDA address book entry is associated therewith in one

portable hand-held device". Claim 2 recites "wherein identifying a location includes

identifying a location based on electronic map data". Claim 3 recites "wherein identifying

a location includes identifying a location based on a GPS-determined current location".

Claim 4 recites "wherein identifying a location includes identifying a location based on

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electronic map data and a cursor position on the electronic map". Claim 5 recites

"identifying electronic map feature data associated with the location" and "pre-filling the

PDA address book entry using the electronic map feature data associated with the

location". Thus, these claims require some form of associating a PDA address book entry

with a location identified based on electronic map data or GPS capabilities. On pages 18-

20, the specification provides further explanation:

> For example, a PDA user who is in a restaurant is able to use the GPS functions to identify the location of the restaurant for future use, and perhaps even the name and address if that information is available in the map data. Rather than create and store a separate waypoint for the electronic map, a PDA address book entry is capable of being created for that restaurant. This PDA address book entry is capable of being pre-filled with data already contained within the electronic map. According to the present invention, as will be described in more detail below with respect to Figure 11, addresses are able to be estimated from address ranges contained in the electronic map. The PDA user is able to edit the pre-filled data to provide a new or more descriptive name, or to provide a precise address. The PDA user also is able to add data to the PDA address book entry, such as a phone number, comments and a desired waypoint symbol. The PDA user is able to retrieve the PDA address book entry created from the location/feature, locate the restaurant on the electronic map, and receive navigational routing and guidance to the restaurant. As is clear upon reading and comprehending this disclosure, other integrated GPS/address book functions are available. As such, the above-described restaurant example should not be read to limit the invention.
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> Figure 11 illustrates one embodiment for estimating an address within an address range. In one embodiment, estimated address are used to pre-fill a PDA address book entry. According to this embodiment, the position 1146 of the PDA 1138 is determined via the GPS device methods described above. In Figure 11, for example, it is determined that the PDA 1138 is traveling on 51st Street. An address range 1148 is associated with the position of the PDA 1138. In the illustrated example, it is determined that the address number range 1148 is from A502" at 1150 to A598" at 1152. The distance traveled from the beginning of the address number range (502 51st

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Street) at 1150 to the position 1146 of the PDA 1138 is determined. An address is estimated based on the address number range 1148, the length 1154 of the road associated with the address range 1148, and the distance 1156 from the beginning of the address number range 1148 at 1150 to the position 1146 of the PDA 1138. An estimated address number 1158 is derived based on this information. In the illustrated example, the estimate proximate address 1158 is estimated to be A556". According to some local rules or standards, the address ranges on one side of the road are odd and on the other side of the road are even. The PDA 1138 is able to determine whether the desired estimated address number falls within the odd or even address range. Although this address is an estimation, it is noted that this estimation often will be enough to find or re-find the subject of the PDA address book entry. In the above-described restaurant example, the estimated address is close enough to travel back to and find the restaurant without the assistance of GPS guidance and the like.

Thus, the present invention, as claimed, actually creates the address book entry around a location based upon map data and GPS information, whether that location is a present location or identified from a map. More specifically, by way of example, in the example discussed above, the user identifies their present location. The GPS receiver resolves that location to a set of coordinates. The map data, with reference to the coordinates, is used to resolve an address, which is used to populate an address book entry.

Alternatively, by way of another example, the user could position the cursor over the map, at a location other than their current location. In this case, the map data, with reference to coordinates for that location, is used to resolve an address, which is used to populate an address book entry. In either case, as claimed in claim 1, the address is

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resolved, thereby associating the "address book entry with the identified location ... in one

portable hand-held device".

In contrast, as discussed above, Yokoyama's electronic diary 10 provides some

PDA functionality and his navigation apparatus 50 provides some GPS and map

capabilities. However, information from Yokoyama's electronic diary 10 is pushed to his

navigation apparatus 50, not the other way around. Specifically, Yokoyama does not

disclose any form of associating a PDA address book entry with a location identified based

on electronic map data or GPS capabilities. Furthermore, as discussed above, Yokoyama

explicitly requires two separate devices. As a result, Yokoyama simply does not disclose,

suggest, or make obvious the limitations of the currently pending claims.

Obradovich removes the association of an address to a location even further.

Specifically, Obradovich teaches a remote data provider performing this step. As disclosed

in column 6, Obradovich's figure 20 "illustrates a typical listing downloaded from a data

provider". Obradovich's figure 20 clearly shows address book type entries with GPS

coordinates already appended thereto. Thus, Obradovich's remote data provider must

have already associated the PDA address book entries with their corresponding location

information before allowing that data to be downloaded onto Obradovich's device.

Specifically, in column 16, Obradovich teaches a user identifiying a location, or area, and

requesting restaurants near that location, or in that area. Thus, the location is identified

with Obradovich's GPS device, but the PDA address book entries are created and

associated with that location at the remote data provider. As a result, Obradovich simply

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does not disclose, suggest, or make obvious "wherein the location is identified and the

PDA address book entry is associated therewith in one portable hand-held device", as

claimed in claim 1, much less the other limitations of the currently pending claims.

Claim 7 now recites "wherein the location is associated with the PDA address book

entry within one portable hand-held device, thereby integrating PDA address book

functions with Global Positioning System (GPS) capabilities in a single device". In contrast,

as discussed above, Yokoyama fails to teach such integration. In fact, as discussed

above, Yokoyama explicitly teaches away from such integration, and therefore cannot

provide the requisite motivation. Thus, the Examiner has failed to the Examiner has failed

to properly establish a *prima facie* case of obviousness, and the present obviousness

rejections cannot be sustained.

As discussed above, Obradovich teaches creating address book entries, with

associated locations, at a remote data provider. Therefore, Obradovich simply does not

disclose, suggest, or make obvious "wherein the location is associated with the PDA

address book entry within one portable hand-held device, thereby integrating PDA address

book functions with Global Positioning System (GPS) capabilities in a single device", as

claimed in claim 7.

Claim 13 recites "wherein associating a location with the PDA address book entry

to form a waypoint includes associating a symbol with the waypoint". Claim 22 recites

"wherein the computer-executable instructions are further adapted to associate a symbol

with the location". Claim 23 recites "the PDA address book entry includes the field

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representing a latitude, the field representing a longitude, and the field representing a symbol" associated with the location. In contrast, neither Yokoyama nor Obradovich discloses "associating a symbol with the waypoint" or location. In fact, the Examiner never even asserts that either Yokoyama or Obradovich discloses "associating a symbol with the waypoint" or location. As a result, neither Yokoyama nor Obradovich discloses, suggests, or makes obvious the limitations of claims 13, 22, or 23.

Claim 14 recites "[a] computer-readable medium having computer-executable instructions adapted to associate a Personal Digital Assistant (PDA) address book entry with a location on *an electronic map that is capable of being displayed on the PDA*", emphasis added. In contrast, as discussed above, Yokoyama's electronic diary 10 simply cannot display any map. Rather Yokoyama requires his navigation apparatus 50 to display any maps. However, the navigation apparatus 50 does not provide any PDA functionality. As a result, Yokoyama simply does not disclose, suggest, or make obvious "an electronic map that is capable of being displayed on the PDA", as claimed in claim 14.

As discussed above, Obradovich associates address book entries with locations at a remote data provider, who does not appear capable of displaying electronic maps. Therefore, Obradovich simply does not disclose, suggest, or make obvious and "instructions adapted to associate a Personal Digital Assistant (PDA) address book entry with a location on an electronic map that is capable of being displayed on the PDA", as claimed in claim 14.

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Claim 15 recites "wherein the computer-executable instructions are further adapted to identify the location based on a GPS-determined current location and then to create the PDA address book entry to be associated with the identified location to form a waypoint". Claim 16 recites "wherein the computer-executable instructions are further adapted to identify the location based on a cursor position on the electronic map and then to create the PDA address book entry to be associated with the identified location to form a waypoint". Claim 17 recites "wherein the location is associated with electronic map feature data, and wherein the computer-executable instructions are further adapted to pre-fill the PDA address book entry using the electronic map feature data associated with the location". These claims each recite some form of creating a PDA address book entry using electronic map data.

In contrast, Yokoyama simply doesn't work that way. As discussed above, information from Yokoyama's electronic diary 10 is pushed to his navigation apparatus 50, not the other way around. Simply put, Yokoyama's navigation apparatus 50 does not provide the electronic diary 10 any electronic map data that could be used in creating a PDA address book entry. Similarly, Obradovich simply doesn't work that way either. Applicant is unable to find any teaching within Obradovich that suggests the limitations of the currently pending claims. Rather, as discussed above, Obradovich clearly teaches creating the address book entries remotely. As a result, neither Yokoyama nor Obradovich discloses, suggests, or makes obvious the limitations of the currently pending claims.

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Claim 19 recites "wherein the computer-executable instructions are further adapted to create the PDA address book entry, and then associate a location with the PDA address book entry to form a waypoint". Claim 20 recites "wherein the computer-executable instructions are further adapted to display the waypoint on the electronic map". Claim 21 recites "wherein the computer-executable instructions are further adapted to provide route guidance to the waypoint". Thus, these claims explicitly require the same set of computer instructions that associates "a Personal Digital Assistant (PDA) address book entry with a location on an electronic map that is capable of being displayed on the PDA", as claimed in claim 14, to also form, display, and/or route to the waypoint. As discussed above, both Yokoyama and Obradovich require multiple components to provide this functionality. Thus, neither Yokoyama nor Obradovich discloses, suggests, or makes obvious the limitations of the currently pending claims.

Claim 27 recites "a field representing an altitude". In contrast, neither Yokoyama nor Obradovich even include the word "altitude". Thus, neither Yokoyama nor Obradovich discloses, suggests, or makes obvious the limitations of claim 27.

Claim 28 recites "[a] Personal Digital Assistant (PDA) device with an integrated electronic map and address book" and "wherein the device is adapted to associate a location that is capable of being displayed on the electronic map with a PDA address book entry to form a waypoint". Claim 30 recites "wherein the device is adapted to pre-fill data fields in the PDA address book entry with electronic map data associated with the location". Claim 32 recites "wherein the device is adapted to create the PDA address book entry, and

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then identify the location associated with the PDA address book entry". Claim 33 recites

"wherein the device is adapted to route to the waypoint on the electronic map". Claim 35

recites "a Global Positioning System (GPS) receiver integral to the PDA". Claim 36 recites

"wherein the location associated with the PDA address book entry is determined by a GPS-

determined location of the GPS receiver". Claim 37 recites "wherein the location

associated with the PDA address book entry is determined by a cursor position on the

electronic map".

In contrast, as discussed above, Yokoyama requires his navigation apparatus 50

to provide mapping capabilities, which his electronic diary 10 simply cannot provide.

Obradovich's device relies on the remote data provider for associating the location and

address book entry. Simply put, neither Yokoyama nor Obradovich discloses integration

of the claimed functionality, such as GPS capabilities, routing capabilities, map data

manipulation, and associating locations with address book entries, into one device. As a

result, neither Yokoyama nor Obradovich discloses, suggests, or makes obvious the

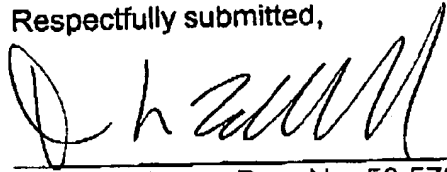limitations of the currently pending claims.

. The remaining claims all depend from claims 1, 7, 14, 23, or 28, and are therefore

also allowable.

Any additional fee which is due in connection with this amendment should be

applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of

Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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